

Specification

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to provide an enabling disclosure. The rejection made on 6-20-95 is maintained.

Claim Rejections - 35 USC § 112

Claims 17-19 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Claims 11-15 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 11, line 12, "said parallel connection" lacks antecedent basis.

Claims 12-15 are rejected under 35 U.S.C. § 112, fourth paragraph, as being of improper dependent form for failing to further limit the subject matter of a previous claim. The rejection made on 6-20-95 is maintained.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1-11, 20, and 21 are rejected under 35 U.S.C. § 103 as being unpatentable over the acknowledged prior art in view of Stacey et al. and Thanawala. The rejection made on 6-20-95 is maintained.

Claims 12-15, 17-19 are rejected under 35 U.S.C. § 103 as being unpatentable over the acknowledged prior art in view of Stacey et al. and Thanawala as applied to claims 1-11 above, and further in view of Gilardi et al. The rejection made on 6-20-95 is maintained.

Response to Amendment

Applicant's arguments filed 9-2-95 have been fully considered but they are not deemed to be persuasive. Applicant argues that one of ordinary skill in the art would be able to make the detecting circuit, current limiting circuit, and switch without undue experimentation and that Applicant is not claiming these elements, but rather the use of such elements in a unique and nonobvious way as specified in claims 17-19.

The first paragraph of 35 U.S.C. § 112 states:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The claim language and the accompanying specification fail to meet the requirements of the statutory language. Applicant has now amended the claim language to recite a switch, a current limiting circuit, and a current detecting circuit. Applicant has further submitted a patent to show that the features claimed are well known and may easily be interpreted by a skilled artisan. While these items may be well known, there is no description in the specification as to what connotes the current limiting circuit, the current detecting circuit, etc.

Applicant further argues that claims 12-15 as amended are no longer indefinite. The examiner respectfully disagrees. The equipment rack panel of claim 12 has nothing to do with the

claimed device for reducing currents, nor does the bracket member of claim 13, utility cart of claim 15, or the monitor saver board and computer of claim 14.

Applicant argues that no reference cited discloses, teaches or suggests a device which is tuned to a harmonic frequency of an AC power supply in substantially addressing the problem of increased neutral currents. The "neutral currents" which Applicant refers to are harmonic currents (see page 1, lines 26-29). Applicant acknowledged on page 2, lines 2-7, for example that devices are known for suppressing harmonic currents when using nonlinear devices in power systems. What the prior art does not disclose is tuning the circuit to filter a third harmonic using a parallel combination of a reactor, a resistor, and a capacitor.

Stacey et al. shows in Fig. 5, for example a cap 60, a reactor 62, and an active resistor (see 28 of Fig. 1) in parallel, where the hybrid filter may be tuned to the third harmonic frequency. Thanawala was further relied upon to teach a passive resistor in parallel with a capacitor and reactor. Applicant argues that the Thanawala reference fails to show the three passive elements connected in parallel, or in series connection between a source and load. First, Stacey is relied upon to teach a filter serially connected between the source and load, not Thanawala. Thanawala was relied upon only to teach a

resistor in parallel with a capacitor and an inductor, which it clearly shows in Figs. 9, 11, 13, and 15.

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969. In this case, one would be motivated to replace the active Stacey resistor with a passive resistor taught by Thanawala, in order to filter unwanted frequencies.

Applicant also argues that the Stacey hybrid filter discloses an active device which generates a ripple current ... under all conditions of input frequency and passive component variations. Column 7, lines 5-10 states that the active element will not come into play, provided that the hybrid filter is tuned to the ripple frequency. That is, if the hybrid filter is tuned to precisely the third harmonic frequency, the active elements

will not create a ripple current as suggested by Applicant. In response to Applicant's challenge that the components recited in claims 17 are well known, Applicant is directed to the patent which he submitted to show such. Lastly, Applicant argues that there is no suggestion to provide filters for a three phase system. Applicant's own acknowledged prior art teaches filtering for a three phase system, by providing a filter for each phase (see page 2, lines 18-22).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sally Medley whose telephone number is (703) 305-3417.

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SUPERVISORY PATENT EXAMINER
ART UNIT 214